REMARKS

IA. Status of the Claims

Claims 1-11 are pending in the application.

Claims 1-11 are rejected.

IB. Status of the Disclosure

1. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the element numbers 61, 25 (figure 3) and Rh, Ro (figure 4A) as described in the specification. Applicant submits that element numbers 61, 25 are shown in figure 3 of the drawing figures 1-7F that were submitted by the undersigned attorney on August 12, 2004 in a Response to a Notice to File Corrected Application Papers mailed on June 15, 2004. An amended drawing sheet 3/5 containing Figures 4A, 4B and 5 is attached. Figure 4A is amended to delete reference elements R_H and R_O as the disclosure makes no reference to these elements. Figure 5 is amended to include reference element 104, which is described on page 6 of the specification. No new matter has been added by these drawing amendments.

2. The Abstract of the Disclosure is objected to because there are more than 150 words. An amended Abstract of the Disclosure is attached that contains less than 150 words.

Amended pages 4-6 of the specification are attached as pages 4, 4A, 5, 5A, 6, 6A to address the incorrect usage of references characters "18" and "42" referred to by the examiner, and to also make various other minor corrections and clarifications. Two sentences corresponding exactly to the text of claim 2 are also inserted on page 4 for clarity. No new matter is added to the specification.

II. Claim Rejections

A. 35 USC §103

Claims 1-11 are rejected under 35 USC §103(a) as being unpatentable over Yei *et al.* (US6621025) in view of Swanson *et al.* (US5068639).

An embodiment of applicant's invention is directed to a rocker switch assembly as defined in claim 1 as follows:

> *1. A rocker switch assembly, comprising:*
> *a switch body including switch contacts;*
> *a mounting strap engaged with the switch body;*
> *a frame attached to the switch body; and*
> *a paddle for actuating the switch contacts,*
> *wherein the paddle has a pivot structure cooperatively engageable with a portion of the frame for selective rotational movement around a pivot axis between a limited forwardly-tilted position and a limited rearwardly-tilted position, further wherein the paddle has a uni-convex cylindrical exterior surface with a curvature, Rp.*

With respect to Claim 1, Yei '025 is alleged to disclose:

- a switch body 1 including a switch contact (per attachment);

- a frame 5 attached to the switch body;

- a paddle 6 for actuating the switch contacts;

- wherein the paddle has a pivot structure cooperatively engageable with a portion of the frame for selective rotational movement around a pivot axis (see attachment) between a limited forwardly-tilted position and a limited rearwardly-tilted position;

-wherein the paddle has a uni-convex cylindrical exterior surface with a curvature, Rp (see attachment).

In regard to claim 2, Yei is said to disclose:

- a paddle 6 having an actuating structure integrally attached to a rear surface thereof having a distal end that operationally enables an open-switch condition and a closed-switch condition.

In regard to claim 3, Yei is said to disclose:

- a paddle 6 having an upper and a lower circumferential surface (see attachment) each having a curvature, R_B, the center of which originates along the pivot axis.

In regard to claim 5, Yei is said to disclose:

- the paddle 6 includes an indicia 61 for identifying one of a position of the paddle and an indication of the switch status.

In regard to claim 6, Yei is said to disclose:

- the indicia 61 is a surface indent.

Regarding claims 1, 4, 7-11, Yei fails to disclose a mounting trap [sic] (*strap*), a faceplate in the form of a frame, faceplate has a uni-convex cylindrical exterior front surface with a curvature, the convex profile of the paddle surface is tangent to a corresponding portion of a convex cross sectional profile of the faceplate surface.

Swanson '639 discloses a wall box dimmer allegedly comprising:

- a mounting strap 34 attached to the switch body 62;
- one of the upper and the lower circumferential surfaces 20 engages a space (see attachment) intermediate a portion of the mounting strap 34 and a surface of the frame 86 in one of the forwardly-tilted position and the rearwardly-tilted position;
- the faceplate 12 in having an opening perimeter defined by upper and opposing lower inner surfaces and left and opposing right inner surfaces;
- the paddle 20 occupies the faceplate opening in an assembled condition;
- the axial centerline of the faceplate opening and an axial centerline of the paddle 20 have a constant intersection point along the pivot axis.

According to the examiner, having found all of the components of application's invention in Yei and Swanson, it would have been obvious to have the faceplate in the form of a frame, faceplate has a uni-convex cylindrical exterior front surface with a curvature and

the convex profile of the paddle surface is tangent to a corresponding portion of a convex cross sectional profile of the faceplate surface or Ra = Rb for the purpose of cosmetic appearance, since such a modification would have involved a mere change in the shape of a component.

Applicant respectfully traverses this rejection on the basis that the Examiner has failed to establish a *prima facie* case of obviousness. The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Examiner. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). In applying either a single reference or combination of references to assert obviousness of Applicant's claim(s), "the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made." MPEP §2142. The Examiner must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claims "as a whole". (*See Panduit v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985), vacated, 475 US 809, 229 USPQ 478 (1986), *aff'd.* on remand, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987).

Applicant respectfully submits that the examiner has failed to show a basis in the art for combining or modifying the primary reference, Yei, in view of Swanson. MPEP §2143.01 provides:

> *The mere fact that references <u>can</u> be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).*

The court in *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998) noted that there were three possible sources for such motivation, namely *(1) the nature of the*

problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art.

III. The Cited Art

Yei '025 is directed to a switch assembly for an LED illumination switch having fewer parts than a disclosed prior art LED illumination switch. The problems of too many tiny parts, assembly time and a clear indication of operating condition are specifically addressed in the '025 patent. The Swanson '639 invention relates to a wall box dimmer designed for easy assembly. The dimmer includes a faceplate 12 and a mounting strap 34 that is attached to the faceplate by stand-offs 22, 24, which are integrally formed parts of the faceplate 12. A back box 62 is secured to the mounting strap by latch arms 64 and 66 to cover the circuit components of the dimmer. These components apparently provide a more efficient dimmer assembly than that of the conventional prior art in which a mounting strap was secured to the faceplate by screws or rivets. In any event, Yei is silent about mounting its rocker switch assembly. The description of the prior art LED switch assemblies discussed in Yei is likewise silent about a mounting component. Despite the fact that Yei shows detailed exploded assembly views of two prior art switch assemblies as well as Yei's assembly, no provision is made for a mounting strap. Swanson, on the other hand, is improving upon a prior art wall box dimmer having a mounting strap. Since there is no disclosure in Yei whatsoever about mounting the LED illumination switch to a wall box, a person of ordinary skill in the art having knowledge of Swanson would not be motivated to incorporate the mounting strap 34 into the switch assembly of Yei. Furthermore, it is not clear to which component of the switch assembly of Yei the mounting strap 34 of Swanson would connect to. Although the Examiner indicates that Swanson discloses a mounting strap attached to the

switch body 62, reference 62 in Swanson is merely a box to cover switch components included on the mounting strap and on Swanson's faceplate 12. Yei already discloses a frame 2 having two legs 22 that engages a base 1 referred to by the Examiner as a switch body. Since Yei's invention is specifically directed at reducing the number of parts in an LED illuminated switch, the incorporation of an additional part having a function that is nowhere disclosed in the primary reference, would actually demotivate one of ordinary skill in the art to further complicate the Yei switch assembly. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness because she can point to no motivation for combining the references as suggested.

With respect to claim 2, which requires an actuating structure integrally attached to the rear surface of the paddle, Yei is not suggestive. Based on the assembly of the Yei device illustrated in Figure 4 thereof, the structure of cap 5 would prevent the assembly of the switch if the activation member 34 was integrally attached to the paddle 6. Swanson does not remedy this defect as it does not disclose the operation of switch 50 described therein. As such, claim 2 is not obvious in view of the cited references.

The Examiner refers to an attached copy of Figure 5 of Yei in support of showing that the paddle 6 has an upper and a lower circumferential surface each having a curvature, R_b, the center of which originates along a pivot axis of the switch assembly. Absent any disclosure or suggestion whatsoever in Yei, the Examiner reads the limitation of claim 3 into the drawing. This is nothing but mere speculation by the Examiner and cannot be justified as a basis for obviating the claim.

In rejecting claim 4, the Examiner relies on Swanson as disclosing that one of the upper or lower circumferential surfaces of the paddle engages a space between a portion of the mounting strap 34 and a surface of the frame 86 when the paddle is in a forwardly tilted or

rearwardly tilted position. A careful observation shows that reference numeral 86 in Swanson, although not discussed, represents a box that may be mounted to a wall stud, to which an entire switch assembly is therein mounted. Whatever component reference numeral 86 is intended to represent in Swanson, it is clearly not a component of the invention. Furthermore, Yei does not disclose or suggest a mounting strap. Since the Examiner has failed to show any motivation for modifying Yei to include the mounting strap of Swanson, it is only upon hindsight reconstruction based on applicant's own teaching that the Examiner relies on to suggest that the limitation of claim 4 is suggested by the references. The mere inclusion of words and arrows provided solely by the Examiner in a copy of Figure 5 of Swanson is not sufficient to establish a *prima facie* case of obviousness. Moreover, the paddle component of rocker switch 50 disclosed in Swanson is neither physically nor operationally a material part of Swanson's invention. Figure 5, provided by the Examiner, fails to show any connection whatsoever between a switch paddle, a mounting strap and a space therebetween. Accordingly, the rejection is improper.

Regarding claim 7, the Examiner relies on Swanson as disclosing a faceplate 12 in the form of a frame having an opening perimeter defined by upper and lower and left and right opposing surfaces. Swanson fails to disclose a faceplate having an opening with a specified perimeter and equally fails to show the faceplate having a uni-convex cylindrical exterior front surface. The Examiner, in point 4 of the office action, expressly states that Yei does not disclose a faceplate in the form of a frame or a faceplate having a uni-convex cylindrical exterior front surface with a curvature. The Examiner is once again relying on hindsight reconstruction based upon applicant's own teaching as the motivation for modifying a non-existent component of Yei based upon a non-existent teaching in Swanson. The rejection is improper and should be withdrawn.

Regarding claim 8, which requires (a) the paddle to substantially occupy the faceplate opening in the assembled condition; (b) a portion of the convex profile of the paddle surface to be substantially tangent to a corresponding portion of a convex cross sectional profile of the faceplate surface in a tilted position; and (c) that no portion of the paddle surface extends beyond the faceplate surface, the Examiner mistakenly relies upon *In Re Daily* to suggest that the claim limitations represent a mere cosmetic appearance involving the mere change in the shape of a component. Since the Examiner has expressly stated that Yei fails to disclose the limitations appearing in applicant's claims 7 and 8, applicant can only presume that a person skilled in the art would be motivated to modify the design and construction of the Swanson dimmer switch assembly merely because they might be able to do so. Applicant respectfully submits that it is not apparent how such a modification of Swanson could be achieved. Applicant further submits that there is no suggestion in Swanson to make such a modification. It is clear that the Examiner is again relying upon hindsight reconstruction based upon applicant's own teaching to suggest modifications of the cited references that are neither disclosure nor suggested. The rejection is improper.

Regarding claim 9, the Examiner relies on Swanson as disclosing the axial centerline of the faceplate opening and an axial centerline of the paddle 20 having a constant intersection point along the pivot axis. Applicant submits that there simply is no such teaching provided by Swanson or Yei either alone or in combination.

With respect to claim 11, applicant disagrees with the Examiner's contention that Yei comprises a paddle 6 including an upper and a lower circumferential surface having a curvature R_b, the center of which originates along the pivot axis, based merely upon the Examiner's self- supplied reference to a curved region of the paddle in a copy of Figure 5 of

Yei supplied by the Examiner. Such an unsupported statement by the Examiner is insufficient to demonstrate a *prima facie* case of obviousness.

IV. Conclusion

Based on all of the foregoing, Applicant respectfully requests reconsideration of the rejected claims and issuance of the pending claims as a patent.

Applicant believes that no extension of time is necessary to make this Response timely. Should Applicant be in error, Applicant respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. §1.136(a) as necessary to make this Response timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 50-1546.

Please direct any questions or comments to William Greener at (607) 330-4012.

Respectfully submitted,

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